

Claims 16-18 have been rejected under 35 U.S.C. §251 as recapturing subject matter previously surrendered in the prosecution of the original application, Serial No. 08/400,260, Patent No. 5,577,767. Paragraph 4 of the Office Action states that the record constitutes an admission by the applicant that the limitation, "an inner cover, the inner cover having a first tear seam", was necessary to overcome the prior art. The Office Action references page 2, 2nd full paragraph of the May 28, 1996 Amendment; and page 5, lines 21-26 and page 6, lines 4-11 and 14-27 of the December 11, 1995 Amendment.

The *Hester* case stands for the proposition that surrender of subject matter may occur through arguments alone in the prosecution of the parent application. *Hester Indus. Inc. v. Stein Inc.*, 46 USPQ.2d 1641, 1649 (Fed. Cir. 1998). There is no unfairness in binding a patentee to "deliberate assertions" made in order to obtain allowance of the original patent claims. *Id.* at 1648.

Specifically, in the prosecution in *Hester*, it was repeatedly argued that the limitations omitted in the reissue claims were what distinguished the original claims from the prior art. *Id.* at 1649. At no less than 42 places in papers submitted to the Patent Office, it was asserted that the omitted limitations distinguished the original claims from the prior art. *Id.* Further, the patentee repeatedly argued that the omitted limitations were "critical" with regard to patentability. *Id.*

This is not the situation in the prosecution of the original claims in this case. No "deliberate assertions" of

the "critical" nature of any limitation were made in the original prosecution. Both of the above argument passages referenced by the Examiner in this case recite the following format: "Claim 6 recites an apparatus comprising..." the elements of claim 6; and, then, "None of the prior art discloses or suggests an apparatus as set forth in claim 6." It is respectfully submitted that this type of argument is not a deliberate assertion of the critical nature of any single limitation, as was the situation in the *Hester* case.

This type of argument, presented in the original prosecution in this case, is general statement regarding the claims as a whole and specific to no one limitation (i.e., a "boiler plate" format) as stated on pages 2-3 of the attached September 21, 1999 Memorandum from Stephen G. Kunin to the Patent Examining Corp. No subject matter has been "deliberately", nor "affirmatively", surrendered by this type of argument.

Additionally, this type of argument does not constitute an admission that any single limitation is necessary to overcome the prior art, as stated in Paragraph 4 of the Office Action. This is merely a statement that the listed limitations do overcome the prior art.

Furthermore, the law does not permit attempts to recapture subject matter affirmatively surrendered during the initial patent prosecution. *B.E. Meyers & Co. v. United States*, 56 USPQ.2d 1110 (Fed. Cl. 2000); *Mentor Corp. v. Coloplast Inc.*, 27 USPQ.2d 1521 (Fed. Cir. 1993). It is respectfully submitted that a statement that the prior art does not disclose what is

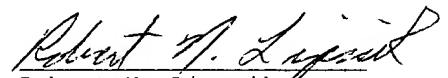
claimed, only repeating the claim language, is not an "affirmative" surrender of any subject matter. By interpreting the argument in the original prosecution in this manner, the Examiner has effectively eliminated the possibility of any broadening in this reissue application (since any limitation removed could be attacked in this way). This is in direct conflict with 35 USC §251 (4th paragraph), which permits enlarging the scope of a patent within two years from the grant of the original patent.

Consequently, it is respectfully submitted that claims 16-18, while broader than the claims of the parent application as permitted by 35 USC §251, do not recapture subject matter surrendered in the prosecution of the original application.

Allowance and reissue of this application is respectfully requested.

Please charge any deficiency or credit any overpayment in the fees for this Amendment to our Deposit Account No. 20-0090.

Respectfully submitted,


Robert N. Lipcsik
Reg. No. 44,460

TAROLLI, SUNDHEIM, COVELL,
TUMMINO & SZABO L.L.P.
1111 Leader Building
526 Superior Avenue
Cleveland, Ohio 44114-1400
Phone: (216) 621-2234
Fax: (216) 621-4072